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1 RECORD OF ORAL HEARING
2 UNITED STATES PATENT AND TRADEMARK OFFICE

3 _____

4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

6 _____

7 *Ex Parte AGATHE SUBTIL, CLAUDE PARROT,*
8 and ALICE DAUTRY-VARSAT

9 _____

10 Appeal 2009-002931
11 Application 10/014,670
12 Technology Center 1600

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14 Oral Hearing Held: September 17, 2009

15 _____

16 Before LORA M. GREEN, RICHARD M. LEBOVITZ, and
FRANCISCO C. PRATS, *Administrative Patent Judges.*

17 APPEARANCES:

18 ON BEHALF OF THE APPELLANTS:

19 DANIEL J. PEREIRA, ESQUIRE
20 Oblon, Spivak, McClelland,
21 Maier & Neustadt, P.C.
22 1940 Duke Street
23 Alexandria, Virginia 22314

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The above-entitled matter came on for hearing Monday, September 17, 2009, commencing at 9:35 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Sussy E. Morehouse, Notary Public.

PROCEEDINGS

THE USHER: Calendar No. 58, Mr. Pereira.

JUDGE GREEN: Good morning.

MR. PEREIRA: Good morning. I can barely see you guys over the screens.

JUDGE GREEN: I know. It's very difficult. If you have a card you can give our court reporter --

MR. PEREIRA: Of course, yeah.

JUDGE GREEN: And then we are familiar with the facts of your case, so, you know, no hurry but whenever you're ready.

MR. PEREIRA: Okay. Let me find a card for you. Yeah, here we go.

COURT REPORTER: Thank you.

MR. PEREIRA: My pleasure.

Let me just organize a few papers here.

JUDGE GREEN: Take your time.

MR. PEREIRA: Well, good morning, and it's a pleasure to be here with you. You've indicated you knew the facts so, obviously, I'm not going to go into those. And I would expect or, wrongly perhaps, that you have some questions for me. So I'll just simply say I think a couple of main

1 points on this case that the Appellants think are probative or determinative
2 as to whether or not you think that the claims here are patentable.

3 We have two obviousness rejections, as you know. I think the
4 rationale on both rejections is similar in many respects, and there is a
5 particular disclosure relied upon in both rejections. The first named
6 author/inventor's name is Demers, D-e-m-e-r-s. That is, I think, at least in
7 our reading of the rejections, is relied upon at great length for the purposes
8 of teaching the aspect of the invention, which is as, of course, as you know
9 from the two main independent claims, the identification of secreted
10 chlamydia, which is a bacteria polypeptide, using the methodology defined
11 in the claims that involves the expression of those proteins through a
12 gram-negative strain and their Type III secretory path link. The Demers
13 disclosure is largely relied upon in the rejections, for example, that -- this is
14 from the Examiner's Answer at page 10, section 1-A -- "Demers teach a
15 method of secreting polypeptides using the Type III secretion machinery of
16 gram-negative bacteria."

17 As I think we explained in the Brief and also in prior responses that
18 are of record in this case, what Demers is actually teaching, it certainly is
19 looking and studying secretion, but it's not looking at whether or not a
20 protein is being secreted in terms of to identify a secreted polypeptide. It's
21 more in the guise of finding agents, compounds, chemical, molecules, what
22 have you, that --

23 JUDGE LEBOVITZ: But the claim --

24 MR. PEREIRA: -- affect the secretory happening.

25 Please. I'm sorry, go ahead.

26

1 JUDGE LEBOVITZ: But the claim is comprising. So the claim
2 doesn't exclude another step in identifying molecules which would interfere
3 with secretion. What --

4 MR. PEREIRA: No, it does not.

5 JUDGE LEBOVITZ: Right.

6 MR. PEREIRA: You're right, it has the word comprising and it does
7 not exclude other steps.

8 JUDGE LEBOVITZ: Right. How is Claim 7, for example, or Claim
9 8, different from Demers? Because Demers does teach expressing secretable
10 protein in gram-negative. What are the differences between Demers and the
11 claim?

12 MR. PEREIRA: Well, I think it's the goal of the method, in the
13 Appellants' view, that is, that it's the identification of a secreted protein, as
14 opposed to identifying something that messes with or alters the secretory
15 pathway itself. So it's -- yeah, I mean, that's -- I think that's the main
16 difference, at least in the Appellants' view.

17 JUDGE LEBOVITZ: What about with the G reference, which is
18 relied upon in the first rejection?

19 MR. PEREIRA: The Griffais?

20 JUDGE LEBOVITZ: Griffais, G-r-i-f-f-a-i-s. What's the difference
21 between the claim and the disclosure in the G reference?

22 MR. PEREIRA: I think there are actually a lot of differences. One --
23 I mean, Griffais is a patent or disclosure that has identified a number of
24 genes or proteins from chlamydia, pneumonia, all right? And that is largely
25 what this patent's about, the cloning and sequencing of these genes.

26

1 There is, as noted by the Examiner, for example, in the Examiner's
2 Answer at page 4, first full paragraph, referencing columns -- I think it's 50
3 and 51 -- that's sort of an indication as to why Griffais teaches a manner of
4 expressing and identifying secreted proteins. I think as the Appellants have
5 explained in their Brief, the -- Griffais doesn't really -- he just says we have
6 all these proteins and you can do sort of any number of known things with
7 them to assess proteins. It's largely just a, you know, a laundry list of
8 prophetic ideas that could be done. It doesn't, I don't think -- and that's
9 probably why, of course, this is an obviousness rejection and it's not an
10 anticipation rejection or an obviousness rejection based solely on Griffais. It
11 just says you can express proteins in various cell types.

12 You know, one of the things that the rejection had outlined is that
13 Griffais allegedly teaches that the preferred host cell is gram-negative
14 bacteria. I'm referencing column 48, again, that's at page 4 of the
15 Examiner's Answer. I don't see that there. I mean, it certainly references,
16 you know, prokaryotic, eukaryotic organisms, etcetera, etcetera. It doesn't
17 say, you know, preferably you need to do this in a gram-negative bacteria.

18 JUDGE LEBOVITZ: Well, it does say preferred host -- to chlamydia,
19 which is a gram-negative.

20 MR. PEREIRA: Sure.

21 JUDGE LEBOVITZ: That's on column 48.

22 MR. PEREIRA: Yeah. The chlamydia -- that's probably not
23 surprising since they're cloning chlamydia genes.

24 JUDGE LEBOVITZ: Right. But at least Claim 7 just says gram-
25 negative.

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1 MR. PEREIRA: Yeah, now I appreciate it.

2 JUDGE PRATS: Yeah, this raises an interesting point because it
3 seems like the Examiner only relies on -- if you look at Answer, the Answer,
4 page 4, relies on Griffais solely for failing to teach that the Type III secretion
5 pathway isn't a Shigella strain, or it says it in Claim 7.

6 MR. PEREIRA: That's right. That's Independent Claim 9.

7 JUDGE PRATS: So it's kind of -- it seems like the Examiner's more
8 rejecting Claim 7 as -- I mean, Claim --

9 MR. PEREIRA: 9.

10 JUDGE PRATS: -- 9 as opposed to Claim 7.

11 MR. PEREIRA: Yeah, I, obviously, can't explain or speak for the
12 Examiner in this regard. But, you know, it has been an argument that we've
13 made both in responses to Office Actions and, I think, as well as in the Brief
14 that we submitted -- we did not submit a Reply Brief -- that -- we talk about
15 the gram-negative strain having a Type III and then we say something like
16 such as Shigella strain, referencing Claim 9. I mean, it is a preferred strain
17 that's used in the present application for conducting these types of
18 experiments. But I don't know why, you know, the rejection or, in this case,
19 the referenced Examiner's Answer focuses on that as being a necessary
20 deficiency in Griffais as to -- in reaching the Demers and the other
21 references. So that was primarily point one.

22 And then, I guess, point two, the main point that the Appellants had
23 outlined in their Brief was the, basically, lack of reasonable expectation of
24 success, that is, okay, Griffais prophetically mentions that you can do any
25 number of things with these chlamydia proteins, and I think the other

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1 reference, which is in the second rejection, by the name of Stephens, which
2 is the primary reference in there, is very similar in that respect. As
3 explained by the Appellants in their Brief, they are of the opinion that you
4 just would not have any -- a prior conclusion as to whether or not chlamydia
5 proteins, polypeptides, would indeed be secreted through a Type III
6 secretory pathway in a gram-negative bacteria.

7 JUDGE LEBOVITZ: But Claim 7 and 9 are just any old gram-
8 negative strain, including chlamydia.

9 MR. PEREIRA: Yes, that's correct. That's correct.

10 JUDGE PRATS: Well, I think it's sort of -- to expand on the point I
11 was making earlier, if we're saying that all the elements are shown in
12 Griffais, at least with respect to the first rejection in Claim 7, it seems -- I
13 mean, why isn't there a reasonable expectation of success?

14 MR. PEREIRA: From Griffais?

15 JUDGE PRATS: Right, by itself.

16 MR. PEREIRA: Again, I just have to defer to what the Appellants
17 have told me, that the Griffais disclosure is directed primarily to the cloning
18 and characterization of some proteins from this bacteria. They mention that
19 you can do any number of things with it, but don't actually do anything with
20 them in that regard. And the conclusion that they had had was that there was
21 no -- a prior conclusion that could be drawn as to the success of expression
22 of chlamydia proteins in other bacteria cells, such as Shigella, which is
23 mentioned in Independent Claim 9. That's their answer to that.

24 So, I mean, I said, those were, I think, the two main points that they
25 wanted to bring to your attention this morning. Obviously, those are
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1 outlined already in the Brief and I don't necessarily need to belabor either of
2 those points. Unless you have some further questions you'd like to ask me, I
3 can leave you alone for the day.

4 JUDGE GREEN: Any questions? No questions?

5 Thank you.

6 MR. PEREIRA: All right. Thank you.

7 JUDGE LEBOVITZ: Thank you very much.

8 MR. PEREIRA: Enjoy the rest of your day. Thank you.

9 (Whereupon, the proceedings, at 9:46 a.m., were concluded.)

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